

Application No. 10/606,786
Response to Office Action dated September 8, 2008

REMARKS

Claim 1 has been amended to require the at least one fatty alcohol to be liquid at 25°C and at 1 atm. Support for this amendment exists, for example, at page 7, lines 3-4, of the present application.

Claim 9 has been amended to delete myristyl alcohol.

Thus, myristyl alcohol (mp = 38°C) is not covered by the claims, whereas lauryl alcohol (mp = 24°C) is covered by the claims.

Claims 1-48 are currently pending, although claims 44-46 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants respectfully request rejoinder of claims 44-46, which depend from claim 1, pursuant to MPEP § 821.04.

The Office Action rejected claims 1-7, 10-14, 17-20, 28-31 and 34-43 under 35 U.S.C. § 102 as anticipated by U.S. patent 5,556,615 (“Janchitraponvej”), and claims 1-43, 47 and 48 under 35 U.S.C. § 103 as obvious over Janchitraponvej in view of U.S. patent 4,390,522 (“Jacquet”), U.S. patent 6,214,326 (“Dupuis”), U.S. patent 6,224,888 (“Vatter”), and J. Am. Oil Chemists Soc. (“Monick”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to transparent compositions containing at least one silicone with quaternary ammonium groups and at least one liquid fatty alcohol: that is, at least one fatty alcohol which is liquid at 25°C and at atmospheric pressure (1 atm). As explained in the Background section of the present application, this unique combination of elements provides, among other things, transparent compositions with good hair conditioning properties despite the fact that such compositions contain liquid fatty alcohol. Such unique compositions are neither taught nor suggested by the applied art. That is, the art upon which

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the Office Action has relied neither teaches nor suggests the claimed invention, nor would such art lead one skilled in the art to the claimed invention with a reasonable expectation of success of producing a transparent composition.

Regarding the rejection under 35 U.S.C. § 102, the Office Action has based this rejection on the assumption that the oleth-20 in Janchitraponvej satisfies the liquid fatty alcohol requirement in the pending claims. However, this is not the case. As demonstrated by the previously-submitted supplier information (Tabs A and B accompanying Applicants' June 3, 2008, Amendment), oleth-20 is solid at 25°C. Thus, oleth-20 is not liquid at 25°C and at 1 atm as required by the claims. For at least this reason, Janchitraponvej cannot disclose all of the elements required by the pending claims, and Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

Regarding the rejection under 35 U.S.C. § 103, Janchitraponvej does not teach or suggest adding the required liquid fatty alcohol to his compositions. This is a significant omission, particularly in view of the fact that Janchitraponvej was seeking to produce "clear" compositions. (See, for example, col. 1, line 12). As explained at page 2, lines 4-6 of the present specification, conventional compositions containing liquid fatty alcohols were not transparent. Thus, the fact that Janchitraponvej was seeking to produce "clear" compositions explains why Janchitraponvej did not include liquid fatty alcohols as possible ingredients for inclusion into his compositions: adding liquid fatty alcohols to his compositions would have resulted in non-transparent compositions and, thus, would have been contrary to his purposes. Under such circumstances, no motivation could have existed to add liquid fatty alcohol to Janchitraponvej's compositions. See MPEP § 2143.01. In other words, no motivation would

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have existed to add a liquid fatty alcohol to Janchitraponvej's compositions with the expectation that a transparent composition would result based upon the teachings of the applied art.

In fact, Janchitraponvej actually teaches away from adding any type of fatty alcohol to his compositions, let alone the required liquid fatty alcohol. This is made clear in Janchitraponvej's discussion of the prior art. Janchitraponvej's "invention" related to clear compositions containing (1) a silicone compound having a quaternary ammonium moiety; and (2) an amidoamine salt. In his "Background of the Invention" section, Janchitraponvej distinguishes Wagman (US 4,777,037) which reportedly discloses a composition containing (1) a silicone compound having a quaternary nitrogen moiety; (2) an amidoamine; and (3) "a long chain fatty alcohol," explaining that Wagman does not disclose the "clear conditioning compositions of the present invention." (See, Janchitraponvej, col. 3, line 48 through col. 4, line 2). Thus, Janchitraponvej distinguishes Wagman's compositions from his clear conditioning compositions. This, by itself, would lead one skilled in the art away from using long chain fatty alcohols in Janchitraponvej's compositions. However, as noted above, several other factors would also lead away from such unintended inclusion of a fatty alcohol into Janchitraponvej's compositions.

Jacquet cannot compensate for Janchitraponvej's deficiencies. That is, Jacquet would not motivate one skilled in the art to add the required liquid fatty alcohols to Janchitraponvej's "clear" compositions (in contravention of Janchitraponvej's disclosure).

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Jacquet's disclosure of alcohols relates to producing "creams." (See, col. 6, line 67 et seq.). Because "creams" are recognized by those skilled in the art as being opaque, not clear, Jacquet teaches adding alcohols to produce opaque compositions, not clear compositions.

Furthermore, Jacquet does not distinguish between different types of fatty alcohols, including solid, liquid, colorless and colored fatty alcohols in his disclosure. Thus, Jacquet did not recognize that the type of fatty alcohol used was a result effective variable, meaning that no motivation would have existed for one of ordinary skill in the art to take pains to select an appropriate fatty alcohol for optimization and use in Janchitraponvej's compositions. That is, no motivation would have existed to select the required, optimized liquid fatty alcohol from Jacquet's general disclosure of alcohols (used to produce non-clear creams) to use in Janchitraponvej's clear compositions. Again, such an addition would have been directly contrary to Janchitraponvej's teachings.

Dupuis, Vatter, and Monick also fail to compensate for Janchitraponvej's fatal deficiencies. Dupuis and Vatter are cited merely for their disclosure of specific compounds. Monick is cited merely for its generic, non-informative disclosure relating to physical properties of alcohols. None of these references would lead one skilled in the art to prepare a transparent composition containing, among other ingredients, a liquid fatty alcohol with the expectation that a transparent composition would actually result. The pending § 103 rejection constitutes nothing more than impermissible hindsight, using the present application as a guide, to combine the required elements together in such a way to yield the claimed transparent compositions. In other words, without Applicants' invention, the rejection could not be supported. Such a rejection is improper and should be withdrawn.

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Applicants respectfully submit that for at least this reason no *prima facie* case of obviousness has been set forth.

Furthermore, even assuming a *prima facie* case of obviousness has been set forth -- which is not the case -- sufficient evidence of unexpected/surprising results exists to rebut any such hypothetical case of obviousness. More specifically, the previously submitted Rule 132 declaration demonstrates the unexpected/surprising results associated with the claimed compositions. The declaration indicates that the demonstrated differences are significant, and demonstrate that the invention compositions have unexpectedly and significantly better flexibility, smoothness and turbidity properties than comparative compositions according to standard testing methods. That is, the invention compositions were determined to be significantly better than comparative compositions using standard testing. Such evidence, by itself, is sufficient to demonstrate the unexpected benefits associated with the claimed compositions.

The unique combination of elements required by the present invention results in compositions having improved sensory and transparency characteristics. Compositions which do not contain either the required silicone with quaternary ammonium groups or the required liquid fatty alcohol do not possess such improved transparency and sensory characteristics. Clearly, the improved compositions of the present invention are neither taught nor suggested by the cited art.

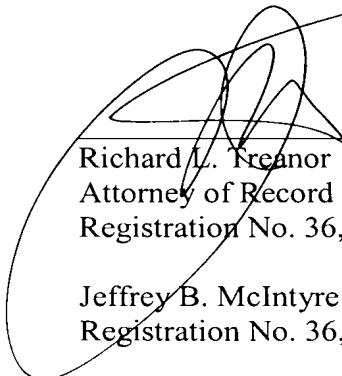
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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